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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,660	11/26/2003	Rick James Morse	D0932-00428 [VS-8855]	8809
8933 7590 03/17/2010 DUANE MORRIS LLP - Philadelphia IP DEPARTMENT 30 SOUTH 17TH STREET PHILADELPHIA, PA 19103-4196				
EXAMINER BUCKLE JR, JAMES J				
ART UNIT 3633		PAPER NUMBER		
MAIL DATE 03/17/2010		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/723,660

**Applicant(s)**

MORSE, RICK JAMES

**Examiner**

JAMES J. BUCKLE JR

**Art Unit**

3633

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 October 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 6-13, 15-17, 22-26 and 30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-13, 15-17, 22-26 and 30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 2/6/2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. The following is a Final Office action in response to communications received on 10/19/2009. Claims 1, 6, 7, 9, 10, 15-17, 25 and 26 have been amended. Claims 27 and 29 have been canceled. Currently, claims 1-4, 6-13, 15-17, 22-26 and 30.

***Response to Amendment***

2. Applicant's amendments to the claims are sufficient to overcome the Specification and Claim Objections set forth in the office action dated 2/19/2009.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Osborn (U.S. Patent No. 3,204,379).

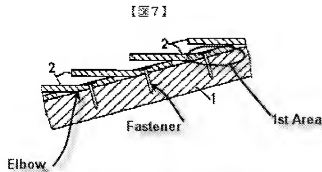
5. Regarding claim 1, Osborn discloses a rectangular panel (10, Fig. 5 and 7) capable of being used as siding, having front and rear faces, first and second side faces and top and bottom faces, the siding panel having a first longitudinal area (1<sup>st</sup> Area) of substantially uniform thickness extending for the length of the siding panel, wherein in the first longitudinal area the front and rear faces of the siding panel have parallel faces extending from the top face to an elbow (approximate 46, Fig. 7) along the length of the

siding panel, wherein from the elbow to the bottom face the front and rear faces extend at an angle with respect to the front and rear faces in the first longitudinal area, wherein when the siding panel is secured to a wall with a bottom end thereof partially overlapping a second siding panel secured below said siding panel, the rear face in the first longitudinal area sits flush with a portion of the wall to which the siding panel is secured so that the wall can provide support for said rear face against burst fractures from fasteners driven through the first longitudinal area.

6. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Yamaguchi (JP405141048) .

7. Regarding claim 1, Yamaguchi discloses a rectangular panel (2, Fig. 7) capable of being used as siding, having front and rear faces, first and second side faces and top and bottom faces, the siding panel having a first longitudinal area (1<sup>st</sup> Area) of substantially uniform thickness extending for the length of the siding panel, wherein in the first longitudinal area the front and rear faces of the siding panel have parallel faces extending from the top face to an elbow (Elbow) along the length of the siding panel, wherein from the elbow to the bottom face the front and rear faces extend at an angle with respect to the front and rear faces in the first longitudinal area, wherein when the siding panel is secured to a wall with a bottom end thereof partially overlapping a second siding panel secured below said siding panel, the rear face in the first longitudinal area sits flush with a portion of the wall to which the siding panel is secured

so that the wall can provide support for said rear face against burst fractures from fasteners driven through the first longitudinal area.



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### ***Claim Rejections - 35 USC § 103***

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
9. Claims 2, 3, 11, and 30, are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi (JP405141048) in view of the Applicant's Admitted Prior Art (AAPA).
10. Regarding claims 2, 3, 11, and 30, Yamaguchi discloses the siding panel as set forth above, but does not specify the panel as being a clapboard, however AAPA teaches that a fiber cement clapboard is a commonly used as a siding panel installed on a wall of a structure. Therefore, it would have been obvious at the time of the invention to one having ordinary skill in the art to have applied the teachings of Yamaguchi including a first longitudinal area as to flatly engage the wall.

11. Claims 6, 7, 9, 12, 13, 15-17, 19, 22-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi (JP405141048).
12. Regarding claims 6 and 15, Yamaguchi discloses a panel as set forth above with a first longitudinal area (1st area) having a height, but does not specify the height as being about at least one inch. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a planar first surface of about at least one inch to meet minimum thickness requirements to yield an ideal structural integrity, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ215 (CCPA 1980). There would be no unexpected or unpredictable results achieved from a finding an optimum value.
13. Regarding claims 7, 16, and 26, Yamaguchi disclose the front and rear faces extending at an angle as set forth above, but does not specify the angle as being between about 1-10 degrees. It would have been obvious to one having ordinary skill in the art at the time the invention was made to an angle between the planar second surface and vertical wall about 1-10 degrees, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233. There would be no unexpected or unpredictable results achieved from a finding an optimum range.

14. Regarding claim 9, Yamaguchi discloses a panel assembly (Fig. 7), capable of being used as a siding, comprising at least first and second siding panels (2) attached to a wall of a structure, each of said siding panels being a rectangular shaped panel having front and rear faces, first and second side faces, and top and bottom faces, said first siding panel having a bottom end of said first siding panel overlaps a top end of said second siding panel, at least said first siding panel having a first longitudinal area (1st Area) of substantially uniform thickness extending for the length of the siding panel, wherein in the first longitudinal area the front and rear faces of the first siding panel have parallel faces extending from the top face to an elbow (Elbow) along the length of the siding panel, wherein from the elbow to the bottom face, the front and rear faces extend at an angle with respect to the front and rear faces in the first longitudinal area such that the rear face in the first longitudinal area sits substantially flush with a portion of said wall, region, wherein said first siding panel secured to said wall at least in part by a series of fasteners (Fastener) extending through said first longitudinal area and into said wall wherein said wall provides support for said rear face against burst fractures from said fasteners. Yamaguchi does not disclose the wall as being vertical. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have utilized the panel assembly disclosed by Yamaguchi on a vertical surface since the panel sidings are capable of being used on a vertical wall.

15. Regarding claims 12 and 13, Yamaguchi discloses an assembly as set forth above installed by a plurality of nails (Fasteners, Fig. 7). The limitations of the nails

being installed by a "blind nail method" or "a face nail method" is considered a product by process limitation, therefore claims 12 and 13 are Product-By-Process claims.

"[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966.

16. Regarding claim 25, Yamaguchi discloses a rectangular shaped panel (Fig. 4, 7), capable of being used as a clapboard siding panel, having a longitudinal length substantially greater than its height and having front and rear faces, first and second side faces and top and bottom faces, the panel having a first longitudinal area (1<sup>st</sup> Area) of substantially uniform thickness extending for the longitudinal length of the siding panel, wherein in the first longitudinal area the front and rear faces of the siding panel have parallel faces extending from the top face to an elbow (Elbow) along the longitudinal length, wherein from the elbow to the bottom face the front and rear faces extend at an angle with respect to the front and rear faces in the first longitudinal area, wherein the rear face in the longitudinal area is a continuous, uninterrupted planar surface arranged for continuous flush engagement with a vertical wall (1, Examiner considers the wall to have a vertical and horizontal component) of a structure across the longitudinal length of the siding panel when the siding panel is secured to the vertical



wall with a bottom end thereof partially overlapping a second siding panel secured below said siding panel such that the vertical wall can provide support for said rear face against burst fractures from fasteners driven through the panel and into said vertical wall through said first longitudinal area, Yamaguchi discloses a first longitudinal area having a height, but does not specify the height as being at least about 1.0 inch. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have a planar first surface of about at least one inch to meet minimum thickness requirements to yield an ideal structural integrity, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ215 (CCPA 1980). There would be no unexpected or unpredictable results achieved from a finding an optimum value.

17. Concerning method claims 17, 19, 22-24 in view of the structure disclosed by Yamaguchi as set forth above, the method of installing the siding panel would have been obvious, since it is the normal and logical manner in which the panel could be installed.

18. Claims 4, 8 and 10 are rejected as being unpatentable over Yamaguchi (JP405141048) in view of DeFord et al. (U.S. PG Pub 2002/0139082).

19. Regarding claims 4, 8, and 10, Yamaguchi discloses the a rectangular shaped siding panel as set forth above, but does not disclose the reinforcing area comprises an embedded or laminated reinforcement layer or comprising a mesh, scrim, fabric or

panel reinforcement. However, Deford et al. teaches that it is known in the art to have a siding panel that comprises of a embedded reinforcement layer that comprises of scrim (para [0016], [0035], [0089]-[0090]) to improve strength and adequately improve the resistance and impact of bending torques that are applied to building under wind loading conditions or other conditions normally faced by building structures. There fore it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the siding panel as disclosed by Yamaguchi with the reinforcement as taught by DeFord et al. to provide a siding panel that was lightweight, economical and maintained the structural integrity and adequate reinforcement to resist forces that a building is normally subjected.

### ***Response to Arguments***

20. Applicant's arguments with respect to claims 1-4, 6-13, 15-17, 22-26 and 30 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

21. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES J. BUCKLE JR whose telephone number is (571)270-3739. The examiner can normally be reached on Monday-Thursday, Alternating Friday 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Dunn can be reached on 571-272-6670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Art Unit 3633

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